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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,590	01/08/2001	Stewart Russell Jurgensen	P-4993	5633

26253 7590 03/10/2004

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/756,590

Applicant(s)

JURGENSEN ET AL.

Examiner

My-Chau T. Tran

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-3,5,7-9,13-22,24-31 and 33-38.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

1. Applicant's response filed 1/29/2004 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance because applicant's arguments for the prior art rejections were considered but are deemed nonpersuasive for the following reasons:

Claim Rejections - 35 USC § 103

2. Claims 1, 5-13, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (US Patent 5,635,362) in view of Van Vlasselaer (US Patent 5,474,687).
3. Claims 19-22, and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (US Patent 5,393,674) in view of Van Vlasselaer (US Patent 5,474,687).
4. Claims 31, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (US Patent 5,393,674) in view of Van Vlasselaer (US Patent 5,474,687).
5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (US Patent 5,393,674) and Van Vlasselaer (US Patent 5,474,687).

Discussion

6. Applicant argues that the combination of Levine et al. (US Patent 5,635,362) and Van Vlasselaer (US Patent 5,474,687) and the combination of Levine et al. (US Patent 5,393,674) and Van Vlasselaer (US Patent 5,474,687) would not be obvious over the presently claimed method because the examiner has incorrectly focused on the density of the gradient solution in Van Vlasselaer to read on the bead density limitation of the instant claims. Therefore, there is no motivation and expectation of success from combining the references. This argument was not persuasive because Van Vlasselaer discloses using a commercially known density gradient

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medium (i.e. "PERCOLL"), which is composed of coated silica particles (i.e. bead). Thus the density of the gradient solution in Van Vlasselaer would read on the bead density limitation of the instant claims. Furthermore, there is a motivation to combine the references because the references teaches the method of density gradient centrifugation (e.g. analogous art) and Van Vlasselaer discloses that the combination of beads and specific binding agents has the advantage of providing for a rapid and high yield procedures to enrich for cell of interest (col. 3, lines 16-28). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success because Van Vlasselaer has shown by examples that using the combination of beads and specific binding agents would increase the enrichment of the cell of interest. Therefore the combination of references would be obvious over the presently claimed invention.

Claim Rejections - 35 USC § 103

7. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (US Patent 5,635,362; which is now refer to as Levine #1) and Levine et al. (US Patent 5,393,674; which is refer to as Levine #2).

Discussion

8. Applicant argues that there is no motivation and expectation of success from combining the references of Levine et al. (US Patent 5,635,362) and Levine et al. (US Patent 5,393,674) because the motivation that both the references involve separation by centrifugation is insufficient to combine the references. This argument was not persuasive because Levine et al. (US Patent 5,393,674) do suggest the desirability for the modification wherein the rib float is for receiving and elongating the sample. Levine et al. (US Patent 5,393,674) that this modification

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would eliminate the possibility of becoming infected by a contaminated sample (col. 1, lines 41-47). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success because both references shows that the cells of interest are confined within the restricted bore of the tube (Levine et al. (US Patent 5,393,674): fig. 5 and col. 4, lines 55-62; Levine et al. (US Patent 5,635,362): fig. 3 and col. 6, lines 40-53). Therefore the combination of references would be obvious over the presently claimed invention.

9. Accordingly, the prior art rejections are hereby maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00 -2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct

March 5, 2004


PADMASHRI PONNALURI
PRIMARY EXAMINER